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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/10/2004

Johann Leban

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10/23/2006

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EXAMINER

CHU, YONG LIANG

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/736,739	Applicant(s) LEBAN ET AL.	
	Examiner Yong Chu	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-106 is/are pending in the application.
- 4a) Of the above claim(s) 1-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 100-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 99-105 have been added by Amendment filed on 25 July 2006.

Claims 1-98 have been withdrawn by the Amendment. Claim 99 is withdrawn by the Examiner as a non-elected claim. Claims 1-106 are pending in the instant application.

Response to Arguments

The Amendments by Applicants' representative Frederick D. Vastine dated on 25 July 2006 has been entered.

Argument over rejection of claims under 35 U.S.C. §112, first paragraph

Applicant's arguments over rejection of claims 67-74 *under 35 U.S.C. §112* (i) have been considered, but are found not persuasive. Applicant's argument on the ground that any compound that can be identified by the active steps of method of identifying claims 59-66 is within the scope of the compounds of claim 67-74, and Examples of such compounds are presented on pages 4-7 of the specification. The examples on page 4-7 of the specification disclose part of subject matter in claims 67-74. However, the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the whole claimed invention. There is no clear definition in claims 67-74, wherein compounds are claimed as applicant's invention, because claims 59-66 do not clearly identify the whole scope of the claimed invention. The specification does not teach how to make or obtain the

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claimed compounds, either. Therefore, the rejection over claims 67-74 is maintained.

Argument over rejection of claims under 35 U.S.C. §112, second paragraph

Applicant's arguments over rejection of claims 67-74 *under 35 U.S.C. §112 (ii)* have been considered. Since applicant does not make argument over the rejection. Thus, the rejection over claims 67-74 is maintained.

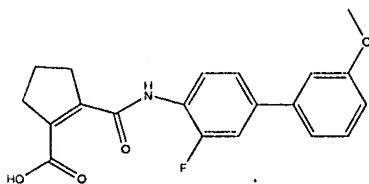
Claims 67-74 have been withdrawn by applicant from further examination.

Argument over double patenting rejection

Applicant's arguments over claims 67-74 under *statute Double Patenting* have been considered, and are found persuasive. The rejection over claims 67-74 is withdrawn.

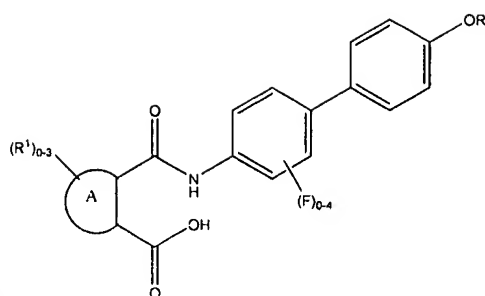
New claims 99-106

Claims 99-106 have been added in this instant application by the amendment filed on 25 July 2006. These new claims contain different subject matter from the previously examined claims 67-74. New round of examination is required. Since claims 99-106 are indefinite under 35 U.S.C. §112, second paragraph, the Examiner interprets the claims based on the elected species



and the examples of the compounds on page 4-7 of the Specification as follows:

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A compound of the formula , wherein

ring A is a 5-membered non-aromatic carbon ring, R^1 is H, or OH; R^a is alkyl, or fluoro substituted alkyl. Claim 99 is withdrawn by the Examiner as non-elected subject matter, because the proviso of claim 99 excludes the compounds of elected species.

Rejection of claims 100-106 under 35 U.S.C. §112 first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 100-106 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 100-106 are drawn to a compound prepared by step (a)-(c), which has formula (I) or (II) according to claims 100-106. However the specification does not disclose a method for making the compounds. The said steps (a)-(c) in claims 100-106 do not describe a method of preparing the claimed compounds, instead is a method of identifying the compounds. The examples on page 4-7 of the

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specification do not disclose whole scope of the invention in claims 100-106, based on step (a)-(c). Therefore, claims 100-106 are rejected.

Claims 100-106 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claimed compounds are novel. The specification should provide enough guideline to instruct one skilled in the art on how to make the claimed compounds with reasonable detail reaction schemes, and references.

Rejection of claims 100-106 under 35 U.S.C. §112 second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 100-106 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 100-106 claimed compounds defined by the method of steps (a)-(c) and has formula (I)-(II) identifying in claims 100-106 of the instant application. However, the method cannot clearly define the scope of compounds and the core structure of the compounds because the definition of the compounds is depended on the parameters used in the method to identify the possible inhibitors. However Office will examine the elected claims based on reasonable interpretation of the scope of invention described supra.

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Claims 100-106 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: steps for preparing the compounds claimed in claims 100-106.

Rejection of claims 100-106 over Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

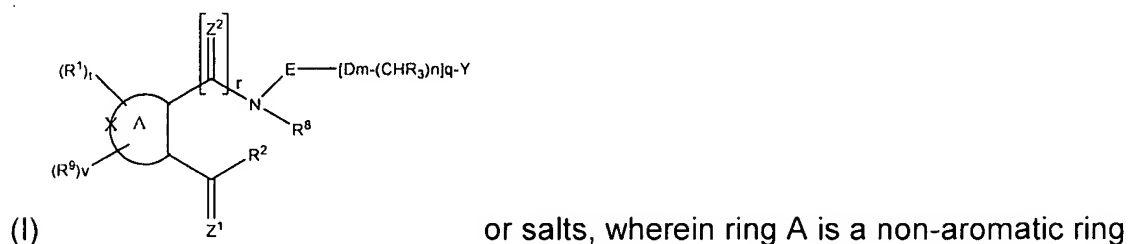
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 100-106 are rejected on the ground of nonstatutory double patenting over claims 1-3 of U. S. Patent No. 7,071,355 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are

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claiming common subject matter, as follows: a compound of the general formula



system containing 4 to 8 carbon atoms, with all the limitations.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusions

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

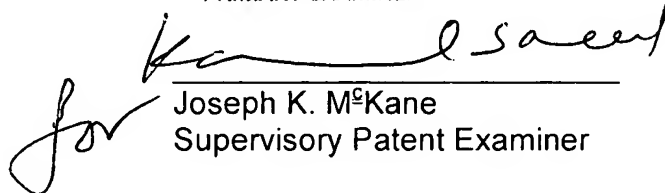
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Patent Examiner

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PRIMARY EXAMINER



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